



1303.39636X00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): I. WATANABE, et al.

RECEIVED

Application No. 09/762,823

FEB 04 2004

Filed: April 23, 2001

TC 1700

For: ADHESIVE FOR BONDING CIRCUIT MEMBERS, CIRCUIT BOARD AND PROCESS FOR ITS PRODUCTION

Group: 1714

Examiner: Edward J. CAIN

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 28, 2004

Sir:

Applicants submit the following comments, and enclosed (unsigned) Declaration Under 37 CFR § 1.132, in response to the Office Action mailed July 28, 2003.

Thus, the sole basis for rejection of claims in the Office Action mailed July 28, 2003, is rejection of all claims being considered on the merits therein, that is, claims 1-21 and 32, under 35 USC §102(a) as anticipated by the teachings of International (PCT) Patent Publication No. WO98/03047 (hereinafter "WO '047", as referred to by the Examiner). WO '047 is the published International (PCT) Application corresponding to U.S. Patent No. 6,328,844, applied by the Examiner in rejecting the claims in the Office Action mailed January 21, 2003, in the above-identified application.

In the Office Action mailed July 28, 2003, the Examiner set forth in Item 5 on page 2 thereof that the rejection of claims 1-21 and 32, under 35 USC §102(a) as

being anticipated by WO '047, "is maintained substantially as set forth in the previous office action with the exception that the international priority document to the US reference is cited".

However, it is noted that 35 USC §102(a) requires that the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent. The printed publication is only prima facie evidence attributing all information therein to the inventors/authors named therein, that the information therein is subject matter of the inventors/authors thereof; where it is shown that the information in the printed publication is to be attributed to present Applicants, the reference is no longer applicable. See Manual of Patent Examining Procedure (MPEP 716.10); see also MPEP 715.01(c). In connection therewith, attention is respectfully directed to the enclosed (unsigned) Declaration Under 37 CFR § 1.132. A signed copy of this Declaration will be submitted when received from Applicants. It is respectfully submitted that this Declaration establishes that any disclosure of the present invention in either U.S. Patent No. 6,328,844 to Watanabe, et al. and in WO '047 is the invention of the present inventors, and not of the inventive entity named in, e.g., WO '047. Note, in particular, Items 5-7 on page 3 of the enclosed Declaration. It is respectfully submitted that this Declaration establishes that the disclosure in U.S. Patent No. 6,328,844 and in WO98/03047 used by the Examiner in rejecting claims is not a description of the invention "described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent" (emphasis added), since the description is of Applicants' invention. Accordingly, it is respectfully submitted that, insofar as applied by the Examiner,

WO '047 does not constitute prior art under 35 USC §102(a) in connection with the subject matter claimed in claims 1-21 and 32 of the above-identified application. See MPEP 716.10.

In view of the foregoing comments and particularly in view of the enclosed Declaration, reconsideration and allowance of all claims presently being considered on the merits in the above-identified application, are respectfully requested.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus, LLP Deposit Account No. 01-2135 (Docket No. 1303.39636X00), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

By 
William I. Solomon
Reg. No. 28,565

1300 North Seventeenth Street, Suite 1800
Arlington, Virginia 22209

Telephone: (703) 312-6600
Facsimile: (703) 312-6666
WIS/sjg